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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,137	01/14/2004	Joseph Philipson	HISHE 60959	3832
24201	7590	04/29/2005	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE TENTH FLOOR LOS ANGELES, CA 90045			ZACHARIA, RAMSEY E	
			ART UNIT	PAPER NUMBER
			1773	
DATE MAILED: 04/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

ML

Office Action Summary	Application No.	Applicant(s)	
	10/757,137	PHILIPSON, JOSEPH	
	Examiner Ramsey Zacharia	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 January 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/8/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Information Disclosure Statement

1. Four non-patent literature references in the information disclosure statement filed 08 March 2004 have been lined through because they fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because no publication date is listed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Independent claims 1 and 6 (and the claims that depend from them) are rendered indefinite because it is unclear if the weight percentages recited are based on the total weight of

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the dried and baked coating or if the weight percentages are based on total weight of the coating composition (including the solvent carrier) used to form the coating.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekon (U.S. Patent 3,983,304) in view of Lewis et al. (U.S. Patent 6,059,867).

Sekon teaches a fastener having a coating capable of protecting the fastener from corrosion (column 1, lines 9-13). The coating is formed from a volatile solvent mixture containing aluminum, polytetrafluoroethylene, zinc and strontium chromates, and a phenol-formaldehyde resin (column 3, lines 29-39). A fatty amido diamine may be added to the coating (column 4, lines 18-25). The coating is formed by drying and baking the mixture after it has been applied to the fastener (column 4, lines 39-43).

Sekon do not teach the presence of the salt of inorganic constituents and the succinic acid (or the succinic acid and an amine complex of the succinic acid) as recited in claims 1 and 6.

Lewis et al. is directed to a corrosion inhibiting coating for metal surfaces (column 1, lines 12-18). Lewis et al. teach a combination of ingredients designed to replace chromates in traditional corrosion inhibiting coatings (column 6, lines 34-37) since chromates are recognized as toxic and carcinogenic (column 1, lines 41-55). The combination of ingredients include a

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combination of zinc salt and (2-benzothiazolylthio)succinic acid or its fatty amine salt (column 6, lines 51-61). Suitable zinc salts include zinc carbonate, zinc oxide, zinc silicates, and preferably zinc phosphate (column 4, lines 29-41). The (2-benzothiazolylthio)succinic acid or its fatty amine salt is present in an amount of up to 10 vol% and the zinc salt is present in an amount of up to 15 vol% (column 5, lines 49-61). These volume percentages should overlap the claimed weight percentages.

One skilled in the art would be motivated to replace the chromates in the coating of Sekon with the ingredients of Lewis et al. because they are specifically designed to replace toxic and carcinogenic chromates in corrosion inhibiting coatings.

Regarding claim 6, Lewis et al. teach that both (2-benzothiazolylthio)succinic acid and the fatty amine salt of (2-benzothiazolylthio)succinic acid may be used for the same purpose. As such it would be obvious to one skilled in the art to use a combination of the two compounds because it has been held to be *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See MPEP 2144.06.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
Tech Center 1700